

REMARKS

Claims 1-20 have been canceled. Claims 21-34 have been added.

The independent claims are directed as follows. Claim 21 requires (in addition to other limitations) “means for selectively reconfiguring a marker . . . by a physician just prior to insertion of the seed into a patient.” Claim 28 requires (in addition to other limitations) that “the seeds [are] adapted to receive the markers just prior to insertion into a patient.” Claim 33 requires (in addition to other limitations) a seed “including a preformed opening for receiving a secondary marker capable of distinguishing that said from others of said seeds in terms of its respective level of radioactivity or half-life; and a secondary marker insertable into the preformed opening just prior to insertion of the seed into a patient.” Thus, each of the independent claims is directed to modifying the seeds or specifically the markers, just prior to inserting the seeds into a patient so that individual seeds can be distinguished from other seeds, for example to identify different levels of radioactivity or half-life in implanted seeds.

U.S. Pat. No. 3,351,049 to Lawrence fails to provide any teaching or suggestion with respect to (i) distinguishing individual seeds from other seeds in a particular set of implanted seeds, and (ii) being able to modify seeds in any manner by a physician just prior to implantation. The Examiner states that the markers in the Lawrence seeds are “capable of being drilled to form a different size or shape by a physician just prior to insertion.” However, the seeds in Lawrence clearly do not include any “means for

selectively reconfiguring a marker just prior to insertion” (claim 21) and are not otherwise adapted to receive a marker just prior to implantation (claim 28). The Lawrence seed does not include any structure which facilitates reception of the markers just prior to insertion into a patient, and there is no teaching or suggestion for the invention, as claimed. Being “capable of being drilled” does not provide the Lawrence seeds with the claimed means and does not make such seeds adapted to receive a marker in accord with claims. Regarding claim 33, Lawrence fails to teach or suggest a seed with a preformed opening, any secondary markers used in conjunction with a first marker, and secondary markers insertable into the preformed opening just prior to insertion of the seed into a patient. For the foregoing reasons, the claims are allowable over Lawrence.

U.S. Pat. No. 6,503,186 to Cutrer teaches that different marker configurations can be provided to different seeds to indicate type of radioactive source and the dosage level of the seeds. However, Cutrer, like Lawrence, also fails to provide any teaching or suggestion of a seed having the limitations of the claims; i.e., directed to the seeds/markers being capable of being reconfigured just prior to implantation and the particular means for doing so. Therefore, the claims are allowable over Cutrer.

U.S. Pat. No. 6,099,458 to Robertson teaches seeds with markers. The Examiner has stated that it is his position that “the seeds are capable of being assembled just prior to implantation as claimed.” However, there is no support for this position in Robertson and Robertson’s teaching is to the contrary. Referring to col. 7, lines 5 – 10:

Each of the one hundred assembled sources is then laser welded under argon atmosphere to provide a hermetic seal around the circumference where the previously open ends of the two end-tubes and the ridge of the annular plug meet. The sources are then ready for surface cleaning, inspection and testing before shipment to medical centers. (emphasis added)

From the foregoing, Robertson teaches seed assembly in an environment requiring laser welding under argon atmosphere to provide a hermetic seal. The equipment and assembly conditions for such are not likely to be found “just prior to implantation”; i.e., at the medical center as posited by the Examiner. However, the seeds of the invention do not require assembly just prior to implantation. They are already sealed and assembled. All that is required is the insertion of a marker into a hole in the seed, if desired, or reconfiguration of a marker, e.g., via the application of heat. For the foregoing reasons, Robertson fails to teach or suggest the claimed invention and the claims are allowable over Robertson.

Furthermore, the dependent claims distinguish the claimed invention over the cited art. Claim 25 requires a seed with a marker reconfigurable just prior to insertion. Claim 26 requires a marker reconfigurable via heat. Claim 27 requires a seed with multiple markers coupled together. Claims 30-32 require markers distinguished by size, shape and length. The invention as defined by these claims is not shown or suggested in any of the cited art.

With respect to the double patenting rejection over the prior claims, the applicant will agree to provide a statutory disclaimer with respect to U.S. Pat. No. 6,712,752 once the claims have been allowed. However, the scope of the claims in the present case is

clearly patentably distinct from the claims in U.S. Pat. Nos. 6,482,143 and 6,200,258. None of the claims in the '143 and '258 patents suggest "means for selectively reconfiguring a marker . . . by a physician *just prior to insertion of the seed into a patient*" (claim 21); "the seeds [that are] adapted to receive the markers *just prior to insertion into a patient*" (claim 28); or seeds "including a preformed opening for receiving a secondary marker . . . and a secondary marker insertable into the preformed opening *just prior to insertion of the seed into a patient*" (claim 33). Particularly, none of the claims of the '143 and '258 patents suggest a seed modifiable *just prior to insertion of the seed into the patient*.

In light of all of the above, it is submitted that the claims are in order for allowance, and prompt allowance is earnestly requested. Should any issues remain outstanding, the Examiner is invited to call the undersigned attorney of record so that the case may proceed expeditiously to allowance.

Respectfully submitted,



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